Hearing:
October 19, 2004

Mailed: January 26, 2005
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Unsworth Transport International, Inc.
v.
UTI Worldwide, Inc.

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Opposition No. 91125078
to application Serial No. 76028602
filed on April 18, 2000

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Ernest D. Buff of Ernest D. Buff & Associates, LLC for Unsworth Transport International, Inc.

Thomas J. Moore of Bacon & Thomas for UTI Worldwide, Inc.

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Before Hairston, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by UTI Worldwide, Inc. to register the mark shown below for "freight brokerage; freight forwarding; freight forwarding by air, sea or land;

shipping of freight; warehouse storage; [and] packaging of freight for transportation."[1]

Registration has been opposed by Unsworth Transportation International, Inc. under Section 2(d) of the Trademark Act on the ground that applicant's mark, if used in connection with the identified services, so resembles opposer's previously used mark "UTi"[2] for transportation and logistical services, specifically the storage, brokerage, transportation and forwarding of freight, as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations in the notice of opposition.

The record consists of the declaration,[3] supplemental declaration, and reply declaration (with exhibits) of opposer's president Paul Unsworth; the declaration, supplemental declaration, and reply declaration (with

[1] Application Serial No. 76028602, filed April 18, 2000, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified services.
[2] Normally, we would use an all-capital letter format to indicate a trademark. However, in this case opposer depicts its mark with a lower case "i". In order to create the same visual impact, we have done the same.
[3] The parties stipulated to the introduction of testimony in this case in the form of declarations. Trademark Rule 2.123(b).

exhibits) of opposer's export manager Carol Lippai; the cross-examination testimony depositions of Mr. Unsworth and Ms. Lippai; four declarations (with exhibits) of applicant's vice president/general counsel Stephen D. Savarese; the declaration (with exhibits) of applicant's attorney Thomas Moore; and notices of reliance submitted by applicant.

Both parties filed briefs on the case and both were represented by counsel at an oral hearing held before the Board.[4]

Before turning to the merits of the case, we must discuss a preliminary matter. For the first time in its brief of the case, applicant argues that opposer has abandoned its UTi mark. Applicant seeks to amend its answer to assert abandonment and argues that opposer's export manager Carol Lippai testified unequivocally that opposer has ceased using its UTi mark. Applicant relied on the following cross-examination testimony of Ms. Lippai:

> Q. Ms. Lippai, I will hand you a copy of page 3 of your declaration in this case and would like to draw your attention to Paragraph 5(B), like baby.
> Can you find the next to the last sentence of Paragraph 5(B) and read it aloud?
>
> A. "The NEMF export/import manager also

[4] We note that opposer attached a copy of an email transmission to its reply brief. Inasmuch as this document was not properly made of record during opposer's testimony period, it has been given no consideration. See TBMP §705.02 (2d ed rev 2004) and cases cited therein.

informed me that it would be better for us to identify ourselves as Unsworth Transport, not UTi, and that by doing this future instances of confusion would likely be avoided."

Q. Do you know the person at NEMF who made that statement?

A. Yes, I do.

Q. Is that someone you've done business with for a number of years?

A. Well, that's who you talk with when you need a shipment picked up, she's the import/export manager. If you have a problem—yeah, for a couple of years at least that I know of.

Q. Has she generally provided satisfactory service to Unsworth Transport?

A. Yes.

Q. Did you relay her recommendation as stated in that sentence to Paul Unsworth?

A. Yes, I did.

Q. Do you recall what—or did Mr. Unsworth make any comment on her statement?

A. Not that I can recall.

Q. With regard to her recommendation, is that a decision that you could make for the company, or would that be a decision someone else would have to make for Unsworth Transport?

A. I would imagine I could make it. And I have done – I have stopped putting the UTi just to save confusion. Because it wastes my time. In fact, the shipment was even delivered to the wrong location because of it. (Lippai dep., pp. 18-20).

Federal Rule Civil Procedure 15(b) provides, in pertinent part, that "[w]hen issues not raised by the pleadings are tried by the express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings." In this case, the question is whether the issue of abandonment was tried by opposer's implied consent. As noted in TBMP Section 507.03(b)(2d ed rev 2004), "[i]mplied consent to trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly appraised that the evidence was being offered in support of the issue." In this case, we cannot say that the above line of questioning, which related to a purported instance of actual confusion, put opposer on fair notice that applicant intended to assert a claim of abandonment against opposer's UTi mark. To allow applicant to amend its answer to assert such a claim at this late juncture would result in undue prejudice to opposer. Under the circumstances, we have given no consideration to applicant's arguments relating to abandonment.[5] Thus, the issues to be determined in this case are priority and likelihood of confusion.

[5] In any event, we should add that Ms. Lippai's testimony concerning actions she took in connection with shipments for a single company, NEMF, does not "unequivocally" establish abandonment of the UTi mark.

PRIORITY

Turning first to the issue of priority, opposer asserts that it has used the mark UTi since at least as early as November 2, 1981.

In his November 6, 2003 declaration, opposer's president, Paul Unsworth testified that he has been employed by opposer for the last six years, and that he performs managerial duties, including routinely reviewing and examining documents associated with the storage, brokerage, transportation and forwarding of freight for opposer's customers. (Declaration, pp. 1-2). Mr. Unsworth testified that opposer is a corporation engaged in the business of providing full domestic and international transportation and logistics services, including cargo handling; warehouse storage; warehousing services; freight brokerage; freight transportation by air, truck, train; freight forwarding by air, sea or land; and custom house brokerage. (Declaration, p. 2).

He also testified that since as early as November 2, 1981 opposer has been using the UTi mark for the above services. (Declaration, p. 2). Exhibit 1 to Mr. Unsworth's declaration is a copy of an air waybill executed on November 2, 1981 bearing the mark UTi. Exhibit 3 is a copy of a brochure opposer has used since 1985 to introduce domestic

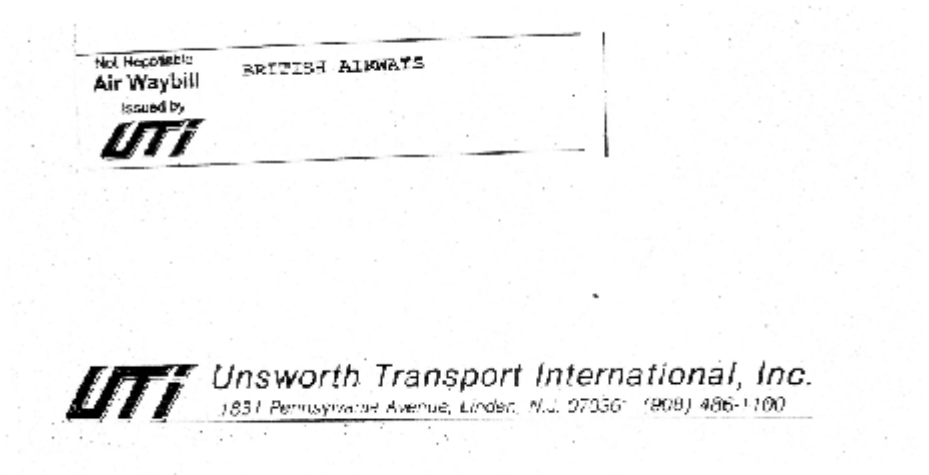
corporations to opposer's services. The brochure bears the UTi mark. Exhibit 4 consists of copies of additional air waybills and transmittal letters bearing the UTi mark. These documents bear dates ranging from 1996 to 2001. Exhibit 22 consists of, inter alia, examples of stationery, air cargo labels, delivery receipts, and warehouse receipts bearing the UTi mark. Opposer has used these types of documents since the adoption of the UTi mark. (Declaration, p. 2).

Further, opposer's export manager, Ms. Lippai testified in her declaration that she has been employed by opposer since 1975. Her duties include arranging and performing transportation and logistics services for opposer's clients. (Declaration, p. 1). Ms. Lippai testified that she is involved in hands-on activities concerning the filing and receipt of bills of lading, airway bills and certificates of origin. (Declaration, p. 1). Further, she testified that prior to December 22, 1999 opposer used the UTi mark in connection with transportation and logistics services, specifically the storage, brokerage, transportation, and forwarding of freight for customers in virtually every state in the United States. (Declaration, p. 2).

Applicant challenges this evidence arguing that opposer has not established prior use of the mark UTi alone. According to applicant, opposer has only used UTi as part of

"UTi Unsworth Transport" and "UTi-Unsworth" and that when used in these manners, UTi does not create a separate commercial impression.

We find that the evidence of record suffices to establish that opposer has used the mark UTi since 1981 in a manner such that it makes a separate commercial expression. In addition to the uncontroverted testimony of opposer's witnesses, the record shows that since 1981 opposer has used the mark UTi on air waybills and transmittal letters. The following examples are taken from an airway bill and transmittal letter:



Applicant, in the absence of any evidence, is limited to April 18, 2000, the filing date of its intent-to-use application, as the earliest date on which applicant can rely. Thus, priority rests with opposer.

Two additional arguments made by applicant concerning the issue of priority require comment. First, applicant argues that opposer does not have priority because opposer

did not register its UTi mark. There is no requirement that a party register its mark in order to establish prior rights therein.[6] Second, applicant argues that opposer does not have priority because opposer has not "consistently" used UTi, that is, opposer has used other marks/trade names, e.g., "UTi Lines", UTI-Unsworth Transport International, Inc." It is well settled, however, that a party may use more than one mark or trade name.

We find therefore that opposer has established prior common law use of the mark UTi for transportation and logistics services, including cargo handling; warehouse storage; warehousing services; freight brokerage; freight transportation by air, truck, train; freight forwarding by air, sea or land; and custom house brokerage.

LIKELIHOOD OF CONFUSION

Our determination under under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I.

[6] We recognize that applicant's counsel obtained a comprehensive search report on the mark/trade name "UTi" prior to applicant adopting its mark. While a search report reduces the chances of falling prey to an unknown senior user, it cannot guarantee that some other party is not using or has not obtained constructive rights in an identical or similar mark. Under our combination of common law rights, in conjunction with the structures set up by the Lanham Act of 1946, the owner of an existing mark, even if that mark is unregistered, may preclude a subsequent user from registering its mark if it can be shown that confusion is likely to result from contemporaneous use of the marks.

duPont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities/dissimilarities between the marks and the similarities/dissimilarities between the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider first whether the marks, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

With respect to the marks, opposer has established prior common law use of the mark UTi as shown below.

Applicant's mark is reproduced below.

Applying the above principles to these marks, it is clear that the letter combination "UTi" is the dominant literal element in each of the respective marks. It is this letter combination that purchasers and prospective purchasers would use to call for opposer's and applicant's services. Although the design element in applicant's mark is prominent, it adds little to the commercial impression created by the mark. To the extent that purchasers and prospective purchasers recognize the letter "u" within the design, it serves to reinforce the "U" in "UTi." In sum, we find that opposer's mark and applicant's mark are

substantially similar in sound, appearance, connotation and overall commercial impression.

Considering next the services, opposer has established prior use of its mark in connection with transportation and logistics services, including cargo handling; warehouse storage; warehousing services; freight brokerage; freight transportation by air, truck, train; freight forwarding by air, sea or land; and custom house brokerage. Applicant's services are identified in its application as "freight brokerage; freight forwarding; freight forwarding by air, sea or land; shipping of freight; warehouse storage; [and] packaging of freight for transportation." As applicant acknowledges in its brief on the case, "[t]he recitation of services in the opposed application is broad enough to encompass the services offered by [opposer]." (Brief, p. 27). There is no question that the services offered by opposer and those intended to be offered by applicant are identical and otherwise closely related.

We recognize that purchasers of the services involved in this case are likely to exercise care in selecting such services. However, even careful purchasers are not immune from source confusion. We find that to be especially the case here where the marks are substantially similar and the services are identical and closely related. See Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA

1962) and Hydrotechnic Corporation v. Hydrotech International, Inc., 196 USPQ 387 (TTAB 1977).

A final matter requires comment. The parties are at odds over whether the record shows actual confusion. Opposer argues that there have been several instances of actual confusion and points in particular to its receipt of mailings, telephone calls and faxes intended for applicant. We are left to speculate, without direct testimony from the callers and writers of the documents, as to whether they were confused or merely careless or inattentive. Suffice it to say that, even assuming that there has, as yet, been no actual confusion, we believe that factor is simply outweighed by the other factors in this case, namely the similarity of the marks and the identity/relatedness of the services. In any event, to be successful in an opposition an opposer need prove only likelihood of confusion, not actual confusion.

We conclude that purchasers familiar with opposer's transportation and logistics services offered under the mark UTi would be likely to believe, upon encountering applicant's mark UTi and design for the services of freight brokerage; freight forwarding; freight forwarding by air, sea or land; shipping of freight; warehouse storage; and packaging of freight for transportation, that the services

originated with or were somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained.